

REMARKS

Claims 1-4, 6-11, 14, and 17-19 and 21-33 were pending as shown in the paper mailed June 7, 2004.

Restriction as between 18 different Groups is now required. In particular, all of the pending claims were classified in 18 different groups. Each group includes a single functional domain set forth in dependent claims 14 and 33.

Applicants traverse the Restriction Requirement and supporting remarks.

It is well settled that two criteria must be met for a proper restriction requirement under M.P.E.P. § 803: (1) the inventions must be independent or [*sic*] distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicant respectfully submits that the Examiner has not met either criterion.

With regard to the first criterion, the Office asserts that "each of the inventions of Groups I-XVIII requires an additional separate search directed to specific protein functional domains...." However, the specific protein functional domains appear only in dependent claims 14 and 33 and no reasons are given with regard to independence or distinctness of independent claims 1 and 21. Indeed, the Office acknowledges that the independent claims (claims 1 and 21) are not patentably distinct from each other, as they are classified in all of the 18 allegedly distinct Groups. Simply put, the Office has not established that the "inventions" of Groups I-XVIII are independent and distinct.

Applicants also traverse on the grounds that the second criterion (unduly burdensome search requirement on the Office) has not been met. Any search for references relevant to the subject matter of independent claims 1 and 21 (classified in all 18 Groups) will **necessarily and in all cases** reveal art relevant to all claims, including modified plant zinc finger proteins comprising the various functional domains recited dependent claims 14 and 33, which form the basis of the Restriction. There is no need to search for references relevant to the various functional domains, as they are not claimed independently of their association with a modified plant ZFP.

Thus, the proper search for the pending claims is a search for references relevant to modified plant ZFPs, as set forth in claims 1 and 21. Indeed, the necessary search for references relevant to modified ZFPs has already been conducted, as evidenced by the substantive examination in this case that preceded the filing of the RCE on June 7, 2004. Therefore, not only do the various functional domains not need to be searched separately, the proper and relevant search for the subject matter of the independent claims has already been conducted.

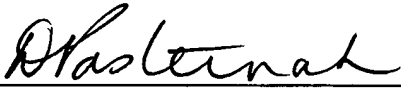
In sum, the Restriction Requirement cannot stand because the two criteria of M.P.E.P. § 803 (*i.e.*, distinctness and undue search burden) have not been fulfilled.

Solely for the purposes of compliance with 37 C.F.R. § 1.143, Applicants elect, **with traverse**, Group IX, drawn to a composition comprising or encoding a modified zinc finger protein and a C1 functional domain.

Applicants expressly reserve their right to petition the Restriction Requirement if it is made FINAL and also reserve their right under 35 USC § 121 to file one or more continuing applications directed to the nonelected subject matter during the pendency of this application.

Respectfully submitted,

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